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No. 98-779

IN THE
Supreme Court of the United States
OCTOBER TERM, 1998

UNITED STATES SURGICAL CORPORATION
Petitioner,

v.

APPLIED MEDICAL RESOURCES CORPORATION,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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REPLY TO BRIEF IN OPPOSITION

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TABLE OF AUTHORITIES

Cases: Page

Aro Manufacturing Co. v. Convertible Top Replacement Co., 365 U.S. 336 (1961) 5, 6

Dana Corp. v. IPC Ltd. Partnership, 860 F.2d 415 (Fed. Cir. 1988) 2

Markman v. Westview Instrument, Inc., 517 U.S. 370 (1996) 2

Pannu v. Iolab Corp., 155 F.3d 1344 (Fed. Cir. 1998) 3

Studiengesellschaft Kohle mbH v. Eastman Kodak Co., 616 F.2d 1315 (5th Cir. 1980) 4

Statutes:

35 U.S.C. § 112 ..... 2, 3

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"But [Parylene-C] was one of the components that made up our seal." Inventor Mark A. Ritchart. Pet. App. at 42a.

1. The brief in opposition states that "the panel did not distinguish among *elements* of the claimed inventions but, instead, properly distinguished between *entire trocar devices which incorporate the claimed inventions* and *the inventions claimed* in the three patents-in-suit . . . ." Br. Opp. 6. However, the inventions here—as measured by the claims—consist of trocar seal assemblies,[1] not just those elements (the pre-dilator, the protector, and the

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[1] Respondent sought to protect its innovations in trocar seal assemblies. It therefore naturally claimed the seal assembly—including the seal. The claims at issue are set forth in full at Pet. App. at 27a-28a, 32a-33a, 37a-38a. Again, "seal," "septum," and "valve" are interchangeable words, all meaning "seal."

floater) that do not depend on the undisclosed Parylene-C coating for their mechanical operation. The seal itself is an element of each asserted claim, as the Court of Appeals noted. Pet. App. at 4a.

As respondent notes, petitioner has asked this Court to "focus on *a single claim element*—the seal—in assessing whether the claims-in-suit satisfied the best mode requirement of 35 U.S.C. § 112 ¶ 1." Br. Opp. 7. *This is exactly correct.* There is no basis whatsoever for believing that Congress intended for an inventor's best mode obligation to extend to some claimed elements but not to others. Since a combination claim always consists of two or more elements, the best mode contemplated by the inventor of carrying out each and every element of the claimed envention must be disclosed.

Respondent asks that the claim be considered "as a whole" but "the whole," as urged by respondent, is less than the sum of its parts. Respondent's "whole" eliminates the seal element of each asserted claim. Under respondent's approach, the measure of "invention" is what the inventor, in subjective assessment of his invention in litigation, construes to be the scope of his or her invention (*see* Op. Br. 8), when viewed "as a whole." This is contrary to *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996). The "invention" is as set forth to the public in the written claim as allowed by the Patent and Trademark Office ("PTO").

Petitioner and respondent both agree that the Court of Appeals declined to measure best mode relevancy by the claim as allowed by the PTO. Thus, the Court of Appeals in its opinion in this case distinguished its otherwise directly on point precedent, *Dana Corp. v. IPC Ltd. Partnership*, 860 F.2d 415 (Fed. Cir. 1988) (also involving an undisclosed coating for a seal) on the ground that the claim in *Dana* was "directed to" the seal element, while the claim in this case was not so "directed." Pet. App. at 5a. Petitioner stresses that respondent does not take ex-

ception to petitioner's statement (pet. at 8) that *Dana* is otherwise directly on point. *Dana* could not be distinguished if best mode relevancy were objectively measured by the claim elements themselves.

Petitioner believes that this case is of exceptional public importance precisely because best mode relevancy, under 35 U.S.C. § 112 ¶ 1, must be objectively measured by the claim (including each and every element of it) as allowed by the PTO.

2. Respondent asserts that petitioner did not clearly and convincingly show that Parylene-C was the best mode of the "inventors." Br. Opp. 3. The plural—inventor*s*—is the key to respondent's argument. Respondent argued to the jury, to the District Court (on petitioner's motion for JMOL), and to the Court of Appeals that petitioner had not clearly shown that Parylene-C was the preferred mode because it had not shown that *all* inventors preferred Parylene-C.

This argument is not open to respondent. 35 U.S.C. § 112 ¶ 1 requires that the patent specification "shall set forth the best mode contemplated by the inventor of carrying out his invention." If more than one inventor files for a patent, and the inventors are in disagreement over their "best mode," the statutory answer is that the best mode of *any* inventor must be disclosed. Congress did not intend for multiple inventors to suppress best modes until they (if ever) reached consensus on their preferred mode. The Court of Appeals so stated in *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1351, n.5 (Fed. Cir. 1998). The Court of Appeals did not reach respondent's alternative ground of affirmance because it lacked arguable legal merit.

3. Respondent seems critical that petitioner based its best mode defense on the testimony of its former employee, co-inventor Mark A. Ritchart. Opp. Br. 3. Best mode is an affirmative defense that typically requires testimony from the inventor, especially as it is necessary to ascertain the best mode *contemplated* by him or her at the time of the invention. 35 U.S.C. § 112 ¶ 2. Ritchart headed respondent's research and development depart-

ment. He oversaw development of the trocar seal inventions at issue. Co-inventor Hart acknowledged that he was "the boss." Pet. App. at 47a. Ritchart was the inventor who selected Parylene-C as the preferred lubricant for respondent. Opp. App. at 1a.

Ritchart's testimony was clear that Parylene-C was his preferred mode at the time that he and his co-inventors filed for the first ('737) patent, and at all times thereafter. Pet. App. 39a-40a. His testimony was also fully corroborated in the excited utterances in co-inventor Gadbery's laboratory notebook dated one month before respondent filed for the '737 patent. Pet. App. 24a. The striking oddity of this case is the clarity of the admission from the inventor-in-charge that he failed to disclose the best mode contemplated by him.[2] It makes this case unique in the annals of best mode litigation.

4. Respondent cites its experience with "flaking" in the months after it filed for the '737 patent. Opp. Br. 3. This flaking ocurred during experimentation *after* respondent filed for the initial ('737) patent (and was resolved before he applied for the '336 patent). Opp. App. at 4a. The flaking also did not arise in connection with the application of Parylene-C to the grade of C-flex® that Gadberry selected in his pre-'737 work. Opp. App. at 4a-5a.[3]

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[2] Respondent of course acknowledged in the Court of Appeals that Parylene-C was the preferred coating of inventor Ritchart: "Ritchart's ultimate decision to proceed with Parylene—and the obvious consequence that Applied tested and used Parylene-C thereafter—does not negate co-inventor Hart's subjective belief that silicon oil was a better seal coating." Brief for Plaintiff-Appellee Applied Resources Corp., No. 97-1526, p. 21 (Dec. 19, 1997). Again, the Court of Appeals did not—and could not—sustain the judgment on the ground that another inventor (Hart) stated a preference for a different (and also undisclosed!) coating because 35 U.S.C. § 112 ¶ 1 requires disclosure of the best mode of *any* inventor. (Hart also was not involved in finding a suitable coating; there is no test evidence that silicon oil, which he claimed to prefer, would work with C-flex®.)

[3] An inventor's best mode disclosure obligation is of course not deferred until he discovers a better mode. *Studiengesellschaft Kohle*

Thus, the Court of Appeals correctly ignored respondent's flaking argument because it did not bear on the fact that Parylene-C was the best mode contemplated by Ritchart when respondent filed for each of the three patents at issue.

5. Respondent states that there was "substantial trial testimony" that Parylene-C "had nothing to do with carrying out the claimed inventions." Opp. Br. 5. It also cites to the District Court. *Id.* The inventors (and also respondent's expert witness) testified that the "inventions" (in their personal view) consisted of the pre-dilator, the protector, and the floater. Based on their testimony, the District Court shared the same view. Petitioner of course acknowledges that there is substantial evidence to support the judgment *if* the inventors and their expert are allowed to *redefine* "invention" so as to exclude the seal—despite the seal being a stated element of each and every asserted claim.[4]

6. Respondent asserts that petitioner misconstrues this Court's decision in *Aro Manufacturing Co. v. Convertible Top Replacement Co.*, 365 U.S. 336 (1961) (*Aro I*) on the ground that petitioner requests that the seal element of each asserted claim be "separately viewed." Opp. Br. 7. To be precise, petitioner asks that the seal element be *viewed* like any other element in an allowed claim and not be "interpreted" out of the seal assembly claims asserted by respondent against petitioner.[5]

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mbH v. Eastman Kodak Co., 616 F.2d 1315, 1339-40 (5th Cir. 1980).

[4] Again, "seal," "septum," "valve," and "orifice" (the hole in the seal) permeate the claims—not just the claim element claiming the seal. Pet. App. at 27a-28a, 32a-33a, 37a-38a.

[5] Respondent is silent on '737 claim 10, in which it claimed the C-flex® material. *See* Pet. at 5, n.4 & 15, n.14. In short, the inventors inform the public by specification and claim that C-flex® is the preferred seal material. Yet, under the holding below, the public, while granting respondent long monopolies in trocar seal assemblies, does not receive in return disclosure of the non-obvious,

In truth, it is respondent's position that is inconsistent with *Aro I*. In respondent's view, the seal itself is not part of the "interpreted" claim, and there is therefore no need to disclose Parylene-C even though it was preferred by Ritchart and indeed regarded by him as a component of the seal. Pet. App. at 42a. Respondent's "as a whole" claim approach allows "interpretation" (Opp. Br. 8) of a claim so as to reduce it to "the gist" or "core" of the claim deemed "inventive" by the inventors and their expert witness at trial. Thus, the ultimate measure of the claim for respondent and the Court of Appeals is not the claim as written but inventor and expert testimony describing the "core" of the claim. Pet. at 6.

Best mode law, as implemented in this case by both courts below, suffers from exactly the same defect of reasoning that this Court so powerfully condemned in *Aro I*. An inventor's best mode obligation is, and will be, far less in scope than what Congress mandated unless and until this Court clarifies that "invention" extends to each and every element of a combination patent claim. There could be no issue more fundamental to best mode analysis than what Congress meant by "invention."

7. Respondent asserts that it is "premature" for this Court to accept this case. Opp. Br. 8. To the contrary, an inventor's best mode obligation has existed since the earliest patent statutes. Pet. at 9. Patent cases, like this one, often involve very large economic stakes. Pet. at 7. They consume significant public resources in their trial and appeal. There is no conceivable justification for allowing the evident confusion (as illustrated by this litigation) over the legal standard for assesing best mode relevancy to persist into the future, especially when the jurisprudence of the country's chief patent court is squarely at odds with the statutory meaning of "invention."

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preferred Parylene-C lubricant for the C-flex® seal. *See* Pet. at 4, n.3. This is not a balanced bargain. *See* Pet. at 10.

CONCLUSION

For the reasons stated herein and previously, certiorari should be granted.

Respectfully submitted,

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